

Appl. No. 09/754,264
Amendment/Response in reply
to the Notice of Non-
Compliant Amendment dated
April 27, 2004

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REMARKS/DISCUSSION OF ISSUES

Pending Claims

Upon entry of the present amendment, claims 10,11, 13-15 and 17-20 are pending. It is noted that support for the amendments to claims 14 and 17 is found, for example, at page 5, lines 15-23 and page 7 line 25 to page 8, line 3.

Rejection Under 35 USC § 103(a)

The Office Action rejects claims 10-13 under 35 USC § 103(a) as being unpatentable over *Wang, et al.* (U.S. Patent 5,604,155) in view of *Soichi* (JP 09249966A). For at least the reasons set forth below, claims 10-13 are allowable over the applied art.

The establishment of a *prima facie* case of obviousness required that *all* of the elements of a claim be found in the prior art. It follows that if a single element of a claim is missing from the prior art, a *prima facie* case of obviousness cannot be properly established. Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references relied upon.

First, it is noted that the rejection in view of *Soichi* is wholly improper for at least the following reasons. The Office Action states "...*Soichi* in its table 2, no.2 described using an Al_3Ti target..." Applicants note that table 2 is found in the full-text of the document, which is in a non-English language, and not in the English-language abstract provided. However, as provided in MPEP § 706.02:

"Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a

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rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection."

Accordingly, because the rejection relies on material in a table in the untranslated Japanese document and the English-language abstract does not disclose the subject features of claim 10, this rejection is improper. It is respectfully submitted that if this rejection is to be maintained, a complete translation is required in a subsequent non-final action.

For at least the reasons set forth above, the rejection of claim 10 in view of *Solchi* and the claims that depend therefrom is improper.

Claim 14, as amended, features "...pattern etching an Al layer, which forms beneath said Al-Si-Cu layer; and after the depositing of the Al-Si-Cu layer, annealing the substrate at a temperature of at least 400 °C .

The reference to *Wang, et al.* specifically relied upon, does not disclose at least this feature. To this end, the reference to *Wang, et al.* discloses an anneal step before the depositing of an aluminum-based layer. (Kindly refer to column 2, line 36, and column 4, lines 21-33 for support for the above assertions.) As such, the reference to *Wang, et al.* lacks at least one of the features of claims 14. Therefore, claim 14 and the claims that depend therefrom are patentable over the applied art. Allowance is earnestly solicited.

Claim 17, as amended, features: "...pattern etching said Al layer; and after the depositing of the Al layer, annealing the substrate at a temperature of at

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least 400 °C.”

For reasons substantially the same as those described in connection with the remarks related to claim 14, it is respectfully submitted that the reference to *Wang, et al.* lacks at least the anneal sequence set forth in claim 17. As such, claim 17 and the claims that depend therefrom are patentable over the applied art. Allowance is earnestly solicited.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance.

If any points remain in issue, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, so that late fees may be avoided.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

Respectfully submitted on behalf of
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